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|   |             |                      |                     |                  |
|---|-------------|----------------------|---------------------|------------------|
| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/712,678  | 11/12/2003  | Gene Michal          | 50623.352           | 9070             |
| 7590  | 04/30/2009  |                      | EXAMINER            |                  |
| Cameron K. Kerrigan<br>Squire, Sanders & Dempsey L.L.P.<br>Suite 300<br>1 Maritime Plaza<br>San Francisco, CA 94111 |             |                      | STEWART, ALVIN J    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3774                |                  |
|   |             |                      | MAIL DATE           | DELIVERY MODE    |
|   |             |                      | 04/30/2009          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |
|------------------------------|--------------------------------------|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/712,678 | <b>Applicant(s)</b><br>MICHAL, GENE |
|                              | <b>Examiner</b><br>Alvin J. Stewart  | <b>Art Unit</b><br>3774             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 February 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 44-50,53 and 54 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 44-50,53 and 54 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

***Terminal Disclaimer***

The terminal disclaimer filed on 02/03/09 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,824,559 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

Applicant's arguments with respect to claims 44-50, 53 and 54 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49 & 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaffaroni et al US Patent 4,142,526.

Zaffaroni et al discloses a method of making a coat having the step of adding a copolymer of comonomer ethylene with a carboxylic acid comonomer to a solvent system to form a composition; applying the composition to an implantable medical device (see col. 17, lines 38-42) and allowing the solvent system to evaporate (see col. 21, lines 39-67; col. 22, lines 5-12; col. 22, lines 37-67; col. 29, lines 6-47; and col. 33, lines 11-39). However, Zaffaroni et al does not disclose a carboxylic acid comonomer content of 5% to 50 wt% and a solvent made of chlorinated solvent and a lower alcohol and a medical stent.

Zaffaroni et al discloses the claimed invention except for the content of 5 to 50 wt% of carboxylic acid comonomer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a content of 5 to 50 wt% of carboxylic acid comonomer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding the solvent, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the toluene solvent of the Zaffaroni et al reference with the chlorinated solvent of the application because Applicant has not disclosed that by having the above mentioned solvent provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the toluene solvent because it would perform equally as well.

Therefore, it would have been an obvious matter of design choice to modify the Zaffaroni et al reference to obtain the invention as specified in claim 49.

Regarding claim 54, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the medical device that the coating is applied because Applicant has not disclosed that by changing the medical device will modify the material properties of the coating. One of ordinary skill in the art, furthermore, would have expected Applicant's coating to perform equally well with the stent as disclosed in the Applicant's invention.

Therefore, it would have been an obvious matter of design choice to modify the substrate to a stent to obtain the invention as specified in claim 54.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/  
Primary Examiner, Art Unit 3774

April 27, 2009.